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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/737,687	12/14/2000	Darin Arthur Allen	218	1550

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EXAMINER

POWERS, FIONA

ART UNIT PAPER NUMBER

1626

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/737,687

Applicant(s)

ALLEN ET AL.

Examiner

Fiona T. Powers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☒ Claim(s) 5-8 and 10-17 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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Receipt is acknowledged of the amendment filed December 14, 2005, which has been entered in the file.

Claims 3, 4, 12 and 13 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

In claims 3, 4, 12 and 13, R^2 and/or R^3 can be "Ph" but in claim 1 R^2 and R^3 cannot be Ph.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3 and 4 are rejected under 35 U.S.C. 102(a) as being anticipated by Senokuchi et al. (Chemical Abstracts, 131:184864, 1999), cited.

The reference discloses the claimed compound wherein X and X_1 - X_4 are carbon; R^1 is COOH; R^3 is Ph; R^2 , R^4 , R^5 , R^6 , R^8 , R^9 and

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R^{53} are H; R^7 is $C(=NH)NH_2$; R^{20} is H; and R^{51} and R^{52} form $=O$. Note Registry No. 239453-66-8.

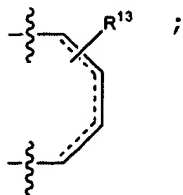
Claim 1 is rejected under 35 U.S.C. 102(a) as being anticipated by Rozylo et al. (Chemical Abstracts, 131:96876, 1999), cited.

The reference discloses the claimed compound wherein X and X_1-X_4 are carbon; R^1 and R^3 are OH; R^2 , R^4 , R^5 , R^6 , R^8 , R^9 , R^{53} and R^{20} are H; R^7 is $C(=O)N(R^{10})_2$ where R^{10} is H; and R^{51} and R^{52} form $=S$. Note Registry No. 208991-55-3.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Nomoto et al. (Chemical Abstracts, 125:167581, 1996) or Ando et al. (US 4767844), cited.

Nomoto et al. disclose the claimed compounds wherein X and X_1-X_4 are carbon, R^1 , R^2 and R^3 are OH; R^4 , R^5 , R^6 , R^8 , R^9 , R^{53} and R^{20} are H; R^7 is $C(=O)N(R^{10})_2$ where R^{10} is H or alkyl; and R^{51} and R^{52} form $=O$. Note Registry Nos. 180206-02-4 and 180206-23-9.

Ando et al. disclose the claimed compound wherein X and X_1-X_4 are carbon; R^1 is OH; R^2 , R^5 , R^6 , R^8 , R^9 , R^{53} and R^{20} are H; R^3 and R^4 form



R^7 is $C(=O)N(R^{10})_2$ where R^{10} is H; and R^{51} and R^{52} form $=O$. Note Example 14.

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Applicant's arguments filed December 14, 2005 have been fully considered and are persuasive. The rejection of the claims under 35 U.S.C. 102(b) over Stecker (US 2906711), Stecker (US 3281466) and Wermuth (US 3793458) has been overcome by the amendment of claim 1 such that one of R⁷ and R⁸ must be a basic group.

Claims 5 to 8, 10, 11 and 14 to 17 are objected to as being dependent upon a rejected or objected to base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The references made of record and not relied upon show the state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fiona T. Powers whose telephone number is 571-272-0702. The examiner can normally be reached on Monday - Friday 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Fiona T. Powers

Fiona T. Powers
Primary Examiner
Art Unit 1626

ftp
March 7, 2006